UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,121	11/14/2003	Anton Joseph Kryka	PM060B	2716

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EXAMINER
HWANG, JOON H

ART UNIT	PAPER NUMBER
2166	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/714,121	KRYKA ET AL.
	Examiner	Art Unit	
	Joon H. Hwang	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>08 December 2006</u>.

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>2-49</u> is/are pending in the application.

     4a) Of the above claim(s) <u>1</u> is/are ~~withdrawn from consideration~~. *Canceled*

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>2-49</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   The applicants canceled claim 1, amended claims 2-48, and added a new claim

49 in the amendment filed on 12/8/06.

Claims 2-49 are pending.

Response to Arguments

2.   Applicant's arguments filed on 12/8/06 have been fully considered but they are

not persuasive.

A. The applicants argue that Lal does not teach or suggest an index file in the

form of a self-describing document in accordance with the document-type definition file.

The examiner respectfully traverses. Lal discloses XML tags as being metadata.

For example, <author> tags tells that data within the tag, that is <author>...</author>,

will be an author's name (lines 30-38 in col. 4 and line 62 in col. 1 thru line 18 in col. 2).

Thus, the XML tags are self-describing. Lal discloses a Document Type Definition

(DTD) used to specify a schema XML data including XML tags (fig. 5 and lines 19-30 in

col. 2). Thus, the DTD is in the form of a self-describing document. Lal discloses two

types of indexes (a hash table index and a tree index) generated based on XML

documents and a DTD file (fig. 7). Lal discloses the indexes containing XML tags and

reflecting the basic structure of the XML document and the DTD associated with the

XML document (lines 17-27 in col. 5, fig. 8, and fig. 9). Therefore, Lal teaches an index

file in the form of a self-describing document in accordance with the document-type-

definition file.

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986).

In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Anderson

discloses indexing of captured data (i.e., images and related data)(sections 60-69 on

pages 2-3, sections 85-97 on pages 6-7, section 131 on page 9, and sections 238-245

on pages 14-15). Lal also discloses indexing of data (i.e., XML) (lines 17-27 in col. 5,

fig. 8, and fig. 9). Anderson discloses the captured data (i.e., check value, payee, date,

check number, etc.) are in XML (sections 1089-1092 on page 56 and section 1107 on

page 56). Anderson does not explicitly disclose indexing of XML data. However, Lal

teaches indexing of XML data, wherein an index file is in the form of a self-describing

document in accordance with the document type definition file (figs. 4, 5, 7, and 9, lines

1-49 in col. 2, lines 30-38 in col. 4, line 64 in col. 4 thru line 35 in col. 5) in order to

effectively search data in XML (lines 31-44 and lines 60-64 in col. 2). Therefore, based

on Anderson in view of Lal, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Lal to the system of Anderson in order to effectively search data in XML.

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, **test is what combined teachings of references would have suggested to those of ordinary skill in art**." In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981).

"Reason, suggestion, or **motivation to combine two or more prior art references** in single invention **may come from references themselves**, from **knowledge of those skilled in art** that certain references or disclosures in references are known to be of interest in particular field, or from **nature of problem to be solved**;" Pro-Mold and Tool Co. v. Great Lakes Plastics Inc. U.S. Court of Appeals Federal Circuit 37 USPQ2d 1626 Decided February 7, 1996 Nos. 95-1171, -1181.

Claim Objections

3.   Claim 25 is objected to because of the following informalities: the claim 25 is depended from the canceled claim 1. Appropriate correction is required.

Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees.   A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163

USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)

may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of

activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

5.   Claim 49 is provisionally rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claim 4 of co-pending Application No.

10/714,122. Although the conflicting claims are not identical, they are not patentably

distinct from each other because of following reasons:

Claim 4 of Patent Application No. 10/714,122 contain(s) every element of claims

49 of the instant application and thus anticipate the claim(s) of the instant application.

Claims of the instant application therefore are not patently distinct from the earlier

patent claims and as such are unpatentable over obvious-type double patenting. A later

patent/application claim is not patentably distinct from an earlier claim if the later claim

is anticipated by the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the

later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at

896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting

because the claims at issue were obvious over claims in four prior art patents); In re

Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of

obviousness-type double patenting where a patent application claim to a genus is

anticipated by a 35 patent claim to a species within that genus). " ELI LILLY AND

COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the

Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30,

2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim

3 of the patent. Thus, the generic invention is **"anticipated"** by the species of the

patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773

(Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any

generic claim) 4. This court's predecessor has held that, without a terminal disclaimer,

the species claims preclude issuance of the generic application. In re Van Ornum, 686

F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354.

Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected

under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29

USPQ2d 2010 (12/3/1993).

This is a _provisional_ obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 2-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Anderson et al. (U.S. Publication No. 2004/0015566) in view of Lal (U.S. Patent No.

6,684,204).

With respect to claim 49, Anderson teaches a document processing system

having at least one computer running system software that interfaces with transport

hardware to provide document control and capture document of images and document

data in various formats, wherein an image file stores a plurality of captured document

images for subsequent retrieval on an individual basis, the system including a computer

readable storage medium storing the system software (sections 60-69 on pages 2-3,

sections 85-97 on pages 6-7, section 131 on page 9, and sections 238-245 on pages

14-15). Anderson teaches indexing the image file by creating an index file containing

indexing data for the captured document images (sections 60-69 on pages 2-3, sections

85-97 on pages 6-7, sections 130-131 on page 9, and sections 238-245 on pages 14-

15). Anderson teaches indexing data for the captured document images allowing

subsequent retrieval of the captured document images on an individual basis (sections

60-69 on pages 2-3, sections 85-97 on pages 6-7, sections 130-131 on page 9, and

sections 238-245 on pages 14-15). Anderson teaches data for the captured document

images are in XML (sections 1089-1092 on page 56 and section 1107 on page 56).

Anderson does not explicitly disclose an index file is in the form of a self-describing

document in accordance with the document type definition file. However, Lal teaches

indexing of XML data, wherein an index file is in the form of a self-describing document

in accordance with the document type definition file (figs. 4, 5, 7, and 9, lines 1-49 in col.

2, lines 30-38 in col. 4, line 64 in col. 4 thru line 35 in col. 5) in order to effectively

search data in XML (lines 31-44 and lines 60-64 in col. 2). Lal also teaches a

document-type definition file including a plurality of elements (fig. 5). Therefore, based

on Anderson in view of Lal, it would have been obvious to one having ordinary skill in

the art at the time the invention was made to utilize the teaching of Lal to the system of

Anderson in order to effectively search data in XML.

With respect to claims 2-5 and 22-24, Lal teaches the document-type definition

file includes a plurality of elements delineating parameters of the document processor, a

plurality of attributes associated with selected ones of the plurality of elements, the

association being set forth in an attribute declaration list, wherein selected attributes

include a choice subgroup, the choice subgroup having at least two values, the plurality

of elements include optional user-defined elements when a predetermined one of the

attribute choice subgroup values is selected, the plurality of user-defined elements

includes parsed character data and unparsed character data, and a parser for

interpreting the data according to the document-type definition file (figs. 4, 5, 7, and 9,

lines 1-49 in col. 2, lines 30-38 in col. 4, line 64 in col. 4 thru line 35 in col. 5).

Therefore, the limitations of claims 2-5 and 22-24 are rejected in the analysis of claim

49 above, and the claim is rejected on that basis.

With respect to claims 6-14, Anderson teaches a check document, a check

account number element, document type for element delineating, a check amount

element, a check account number element, a check routing and transit number element,

a check sequence number element, a transaction number element, and a transcode

element (fig. 38, fig. 42, sections 60-69 on pages 2-3, sections 85-97 on pages 6-7,

section 131 on page 9, section 188 on pages 12, and sections 238-245 on pages 14-

15).

With respect to claims 15-21, Anderson teaches a stub document, an account

number element, an amount element, a date element, document type for element

delineating, a transcode element, and a transaction number element (fig. 38, fig. 42,

sections 60-69 on pages 2-3, sections 85-97 on pages 6-7, section 131 on page 9,

section 188 on pages 12, and sections 238-245 on pages 14-15).

With respect to claim 25, Anderson teaches the document processor is capable
of being connected to other document processors via a network (figs. 1-3).

With respect to claim 26, Anderson teaches a document processing system,
including an imaging subsystem, having at least one computer running system software
that interfaces with transport hardware to provide document control and capture
document of images and document data in various formats, wherein an image file
stores a plurality of captured document images for subsequent retrieval on an individual
basis, the system including a computer readable storage medium storing the system
software (sections 60-69 on pages 2-3, sections 85-97 on pages 6-7, section 131 on
page 9, and sections 238-245 on pages 14-15). Anderson teaches indexing the image
file by creating an index file containing indexing data for the captured document images
(sections 60-69 on pages 2-3, sections 85-97 on pages 6-7, sections 130-131 on page
9, and sections 238-245 on pages 14-15). Anderson teaches indexing data for the
captured document images allowing subsequent retrieval of the captured document
images on an individual basis (sections 60-69 on pages 2-3, sections 85-97 on pages 6-
7, sections 130-131 on page 9, and sections 238-245 on pages 14-15). Anderson
teaches data for the captured document images are in XML (sections 1089-1092 on
page 56 and section 1107 on page 56). Anderson does not explicitly disclose an index
file is in the form of a self-describing document in accordance with the document type
definition file. However, Lal teaches indexing of XML data, wherein an index file is in
the form of a self-describing document in accordance with the document type definition
file (figs. 4, 5, 7, and 9, lines 1-49 in col. 2, lines 30-38 in col. 4, line 64 in col. 4 thru line

35 in col. 5) in order to effectively search data in XML (lines 31-44 and lines 60-64 in col.

2). Lal also teaches a document-type definition file including a plurality of elements

declarations and attribute declarations, wherein the plurality of element declarations

includes first elements related to selected parameters of the document processing

system and second elements related to selected parameters of each at least one

document that is processed, and wherein the attribute declarations include attributes

that describe detailed information about selected ones of the elements (figs. 4, 5, 7, and

9, lines 1-49 in col. 2, lines 30-38 in col. 4, line 64 in col. 4 thru line 35 in col. 5).

Therefore, based on Anderson in view of Lal, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to utilize the teaching of Lal to

the system of Anderson in order to effectively search data in XML.

With respect to claims 27-28, Lal teaches selected first elements include first

child elements and selected second elements include second child elements, the first

child elements are elements defining the attributes and data that are common to

subsequent elements (figs. 4, 5, 7, and 9, lines 1-49 in col. 2, lines 30-38 in col. 4, line

64 in col. 4 thru line 35 in col. 5). Therefore, the limitations of claims 27-28 are rejected

in the analysis of claim 26 above, and these claims are rejected on that basis.

With respect to claims 29-32, Anderson teaches information related to the

imaging subsystem, wherein the imaging subsystem includes an identity of the image

storage means, a camera including at least one attribute, the attribute being the identity

of the camera and the identity of the image file associated with the camera (fig. 38, fig.

42, sections 60-69 on pages 2-3, sections 85-97 on pages 6-7, section 131 on page 9,

section 188 on pages 12, and sections 238-245 on pages 14-15).

With respect to claims 33-35, Anderson teaches an image capture server

including the identity of the image capture server and at least one attribute having a

value identifying the document processing system, wherein the value identifying the

document processing system is selected from the group consisting of a name of the

image capture server and a serial number associated with the document processing

system (fig. 38, fig. 42, sections 60-69 on pages 2-3, sections 85-97 on pages 6-7,

section 131 on page 9, section 188 on pages 12, and sections 238-245 on pages 14-

15).

With respect to claims 36-38, Anderson teaches a plurality of attributes defining

the at least one document in relation to the imaging subsystem, wherein the image

subsystem includes image storage means, wherein one attribute includes information

related to the time it took to store image data of the at least one document in the image

storage means, wherein the imaging subsystem includes a camera, and one attribute

includes information about the skew angle of each at least one document in relation to

the camera (fig. 38, fig. 42, sections 60-69 on pages 2-3, sections 85-97 on pages 6-7,

section 131 on page 9, section 188 on pages 12, section 211 on page 13, and sections

238-245 on pages 14-15).

With respect to claims 39-40, Anderson teaches parsed character data defining

what image character recognition parameters are to be used with the image data of the

at least one document and selected image data of the at least on document are

captured as a clipped portion of a JPEG image, wherein the image file includes a sub-folder that sets out the coordinates to use when capturing the clipped portion of the JPEG image, and wherein the image character recognition parameters are located in the image file sub-folder (fig. 38, fig. 42, sections 60-69 on pages 2-3, sections 85-97 on pages 6-7, section 131 on page 9, section 188 on pages 12, and sections 238-245 on pages 14-15).

With respect to claims 41-47, Anderson teaches a plurality of attributes defining image information of each of the at least one document processed by the document processing system, wherein one attribute includes a document identification number, image character recognition type, information relating to the dimensions of the image, information relating to the resolution of the image, information relating to the compression of the image, information relating to the threshold value for the image (fig. 38, fig. 42, sections 60-69 on pages 2-3, sections 85-97 on pages 6-7, section 131 on page 9, section 188 on pages 12, and sections 238-245 on pages 14-15).

With respect to claim 48, Anderson teaches the document processor is capable of being connected to other document processors via a network (figs. 1-3).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joon H. Hwang whose telephone number is 571-272-

4036. The examiner can normally be reached on 9:30-6:00(M~F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.
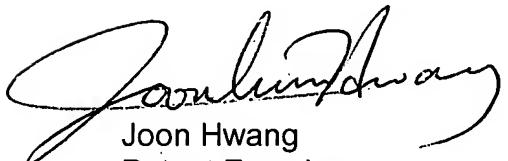
Joon Hwang
Patent Examiner
Technology Center 2100

3/2/07